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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,463	04/12/2004	Christopher S. Grubish	PREZ 2 00437-1	3132

7590 11/18/2004  
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EXAMINER
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MAYO III, WILLIAM H

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/822,463

Applicant(s)

GRUBISH ET AL.

Examiner

William H. Mayo III

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/12/04
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>April 12, 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. 119(e). The provisional application being filed October 17, 2000, as Application No. 60/204,213.

### ***Information Disclosure Statement***

2. The information disclosure statement filed April 21, 2004 has been submitted for consideration by the Office. It has been placed in the application file and the information referred to therein has been considered.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following Figures 3a-3b, 6, 8a-8c, 9, and 11 are not mentioned in the description: The applicant should include a detailed description of the figures in the specification.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 18 recites the limitation "said retaining members" in line 2. There is insufficient antecedent basis for this limitation in the claim because there has not been any previous reference to a retaining member in previous lines of the claims.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-6 and 8-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 8-29 of U.S. Patent No. 6,721,483. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US Patent Number 6,721,483 anticipate all of the claims of the present patent application.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-11, 19-27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Cloud et al (Pat Num 5,884,003, herein referred to as Cloud). Cloud discloses a re-enterable housing assembly (Figs 1-9) for enclosing and storing cable splices (Col 1, lines 35-44). Specifically, Cloud discloses a housing assembly (10, Fig 1) comprising a first and second end plates (18 & 20, respectively) axially aligned and spaced apart from one another (Col 4, lines 6-10, Fig 1), first and second housing members (12 & 14) releasably and sealingly clamped to each other (Col 4, lines 2-6), wherein the housing members (12 & 14) enclose the end members (18 & 20) located at opposite ends of the housing members (12 & 14, Col 4, lines 6-10), a sealing member (i.e. mastic sealant) extending along the length of the housing members (12 & 14) and bonded onto the longitudinal edge of at least one housing member (12 & 14, Col 5, lines 32-35) and end plate seal members (46a) embedded into the grooves of the first and second end plates (18 & 20) located at opposed ends of the sealing housing members (12 & 14). With respect to claim 2, Cloud discloses the housing assembly (10) further comprising a rigid bar (65) having opposite terminal ends (left and right ends) joined to the first and second end plates (18 & 20) to hold them in their axially aligned and spaced relationship (Col 6, lines 44-51). With respect to claim 3, Cloud discloses that

the first and second housing members (12 & 14) includes a plurality of rib elements (26) extending from the exterior surface (30) of the housing members (12 & 14) to form a support for permitting the housing members (12 & 14) to rest stably on the flat work surface (Col 4, lines 45-49). With respect to claim 4, Cloud discloses that the first and second housing members (12 & 14) comprise main body portions (22) with peripheral clamping flanges (24) extending outwardly therefrom and cooperatively positioned in opposed relationships to another of the housing members (12 & 14) to be clamped together (Col 4, lines 41-45), wherein the clamping flanges (24) have inner end portions adjacent the main body portions (inside edge, Fig 2) and having outer end portions (outside edge, Fig 2). With respect to claim 5, Cloud discloses that the sealing member (mastic sealant, not shown) is positioned between the inner end portions of the clamp flanges (46) and is bonded into the inner end portions along the longitudinal axis of the first and second housing members (12 & 14, Col 5, lines 32-35). With respect to claim 6, Cloud discloses that the first and second housing members (12 & 14) each comprise an injection-molded shell (Col 4, lines 11-17). With respect to claim 8, Cloud discloses that the first and second housing members (12 & 14) comprise alignment ribs (40) extending along the length of the first and second housing members (12 & 14, Col 5, lines 1-11). With respect to claim 9, Cloud discloses that the housing assembly (10) further comprises a gasket (46) extending along the longitudinal axis of one of the first and second housing members (12 & 14), wherein the gasket (46) is connected to the end plate seal member (46a). With respect to claim 10, Cloud discloses that the gasket (46) is recessed within a groove (47) along the longitudinally axis of the first housing

member (12) on a first side (left side) and the second side (right side of housing 12).

With respect to claim 11, Cloud discloses that the second housing member (14) carries the seal member (mastic sealant) located on a first side (left side), wherein the gasket

(46) is recessed within a groove (47) along the second housing member (14), wherein

the gasket (46) of the first housing member (12) and the seal member (14) of the

second housing member (14) are compressed together to form a seal (Col 5, lines 30-

35). With respect to claim 19, Cloud discloses that the housing assembly (10) further

comprises a filling flange (68) attached to the outside surface of one of the housing

members (12, Col 7, lines 7-13). With respect to claim 20, Cloud discloses that the

flange (68) may be spin welded to the housing member (Col 7, lines 7-13). With respect

to claim 21, Cloud discloses that the filling flange (68) includes a cap (not numbered)

and an air valve sealed by the cap (not numbered, Col 7, lines 7-13, Fig 2). With

respect to claim 22, Cloud discloses that the filling flange (68) includes a cap (not

numbered) and an check valve capable of injecting encapsulant to the housing

members (12 & 14, Col 7, lines 7-13, Fig 2), wherein the valve is sealed by the cap (not

numbered, Fig 2). With respect to claim 23, Cloud discloses that the filling flange (68)

includes a cap (not numbered) and an grounding plug that may accommodate a

grounding wire (not shown, Col 7, lines 7-13, Fig 2). With respect to claim 24, Cloud

discloses that the end plates (18 & 20) each include fastening means located within the

end plates (18 & 20, Col 5, lines 62-67). With respect to claim 25, Cloud discloses that

the end plates (18 & 20) define at least one hole (52) for cable insertion (Col 5, lines 50-

55). With respect to claim 26, Cloud discloses that the end plates (18 & 20) has

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fastening means (64) comprises a nut strip (i.e. bolt) which distributes loads required to draw end plate sections together to fasten the end plate (18 & 20) to each other (Col 6, lines 10-18). With respect to claim 27, Cloud discloses that an air and ground insert (68) may be molded into an opening within each of the housing members (12 & 14) wherein an associated air valve or grounding insert may be inserted (Col 7, lines 7-13). With respect to claim to claim 29, Cloud discloses that the end plates may having varying outer diameters to accommodate housing members (12 & 14) of various sizes (Col 6, lines 1-24).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cloud (Pat Num 5,884,003). Cloud discloses a re-enterable housing assembly (Figs 1-9) for enclosing and storing cable splices (Col 1, lines 35-44) as disclosed above with reference to claims 1 & 11 above.

However, Cloud doesn't specifically disclose the gasket being made of neoprene rubber (claim 12).

With respect to claim 12, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the housing assembly of Cloud to comprise the gasket to be made of neoprene rubber since it is well known in the art of cables that neoprene rubber is a commonly utilized gasket material because of its excellent abrasion resistance, oil, water, and solvent resistance, long service life, and wide temperature and usable operating ranges and since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

14. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloud (Pat Num 5,884,003) in view of Williamson, Jr (Pat Num 4,538,021, herein referred to as Williamson). Cloud discloses a re-enterable housing assembly (Figs 1-9) for enclosing and storing cable splices (Col 1, lines 35-44) as disclosed above with reference to claims 1 & 11 above.

However, Cloud doesn't necessarily disclose the housing members comprising a plurality of tabs protruding from the first and second sides of each housing member

along the longitudinally axis (claim 13), nor first and second retention members including a plurality of slotted openings to align with the tabs when the first and second housing members are brought together to an intermediate connected position, wherein the retention members clamp the first and second housing members (claim 14), nor the retention members including a pair of members each having a plurality of slotted openings and a plurality of fastening means to secure the pair of slotted members to each other (claim 15), nor the slotted members being generally parallel to each other (claim 16), nor a spacer being compressed between the pair of slotted members to transfer a uniform load along the longitudinally axes of the housing members (claim 17), nor the retention members being outboard the clamping flanges of the housing members (claim 18).

Williamson teaches a housing assembly (Figs 1-10) which encloses a cable splice and which prevents the ingress of moisture and pressurized gas before and after reentry (Col 1, lines 5-11). Specifically, with respect to claim 13, Williamson teaches a cable housing assembly (20) comprising first and second housing members (23 & 24) comprising a plurality of tabs (138) protruding from the first and second sides of each housing member (23 & 24) along the longitudinally axis (Col 8, lines 23-34). With respect to claim 14, Williamson teaches that first and second retention members (138) including a plurality of slotted openings (between the teeth 138) to align with the tabs (138) when the first and second housing members (23 & 24) are brought together to an intermediated connected position, wherein the retention members (138) clamp the first and second housing members (23 & 24, Col 8, lines 23-34). With respect to claim 15,

Williamson teaches that the retention members (138) including a pair of members each having a plurality of slotted openings (spaces between the teeth 138) and a plurality of fastening means (121) to secure the pair of slotted members to each other (Col 8, lines 23-34). With respect to claim 16, Williamson teaches that the slotted members (spaces between the teeth 138) are generally parallel to each other (Fig 1). With respect to claim 17, Williamson teaches that the a spacer (146) is compressed between the pair of slotted members to transfer a uniform load along the longitudinally axes of the housing members (23 & 24, Figs 7-9). With respect to claim 18, Williamson teaches that the retention members (138) are outboard the clamping flanges (Figs 7-9) of the housing members (23 & 24).

With respect to claims 13-18, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the housing assembly of Cloud to comprise the housing configuration as taught by Williamson because Williamson teaches that such a configuration which prevents the ingress of moisture and pressurized gas before and after reentry (Col 1, lines 5-11).

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cloud (Pat Num 5,884,003) in view of Smith (Pat Num 6,177,634). Cloud discloses a re-enterable housing assembly (Figs 1-9) for enclosing and storing cable splices (Col 1, lines 35-44) as disclosed above with reference to claim 1 above.

However, Cloud doesn't disclose the end plates having gripping members comprising teeth for gripping the cable and a slotted elongated member which extends at accommodate cables of varying widths (claim 28).

Smith teaches an housing assembly (Figs 1-11) for housing cable splices and prevents water, dust, debris, snow, etc from entering the splice case (Col 1, lines 55-60). Specifically, with respect to claim 28, Smith teaches an housing assembly (30) comprising two housing members (41 & 42) and two end plate members (51-54), wherein the end plate members (51-54) has gripping members ( ) 62) comprising teeth for gripping the cable (33-35) and a slotted elongated member (Fig which extends at accommodate cables of varying widths (Col 4, lines 21-35).

With respect to claim 28, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the housing assembly of Cloud to comprise the end plate member as taught by Smith because Smith teaches that such a configuration prevents water, dust, debris, snow, etc from entering the splice case (Col 1, lines 55-60).

### ***Conclusion***


16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are Clark et al (Pat Num 4,839,471), Rebers et al (Pat Num 4,857,672), Dagan (Pat Num 5,322,973), Dagan et al (Pat Num 4,721,830), Miller (Pat Num 6,248,953), Mullin et al (Pat Num 4,875,952), Gittle (Pat Num 4,743,209), Goetter (Pat Num 4,549,040), DeCarlo et al (Pat Num 5,425,133), Rebers et al (Pat Num 5,247,135), all of which disclose various housing assemblies.

**Communication**

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William H. Mayo III  
Primary Examiner  
Art Unit 2831

WHM III  
November 15, 2004